

Obviousness Rejection

The grounds and rationale for the obviousness rejection of the pending claims was set forth in part 4 on pages 3-14 of the Office Action. Specifically, the claims are rejected on the grounds that one would have modified the embodiments described on pages 14-16 of Ludwig et al., PCT International Publication Number WO 99/04582 (for the sake of simplicity, these embodiments are hereinafter referred to simply as "Ludwig") in view of U.S. Patent No. 6,560,457 issued to Silver et al to include "generating a request to a location center, to provide the exact location of the mobile with prior identification of the requester." Applicants respectfully traverse the rejection on the grounds that: 1) the rejection fails to establish a prima facie case that the applied references suggest each and every one of the combination of features recited in the rejected claims; and 2) in any event, Silver is not prior art with respect to this application.

No prima facie case of obviousness

Independent claim 130 is directed to a network. The claim requires a first station that is in communication with at least one network element and that establishes a connection with an element external to the network via the at least one network element. The claim specifies that the first station or the network element is provided with a dedicated address that is to receive a request from the external element as to the location of the first station. The dedicated address is such that any request received at the dedicated address is a position request. Independent claims 131-133 recite substantially similar features. Independent claims 134-136 are similar except that they utilize means plus function language authorized by 35 USC 112, sixth paragraph.

The rejection acknowledges that Ludwig does not disclose the features that "one of said first station and said at least one network element is provided with a dedicated address arranged to receive a request from said external element as to the location of the

first station" and that "any request received at the dedicated address is a position request." The rejection appears to imply that these features are disclosed in U.S. Patent No. 6,560,457 issued to Silver et al, when it states (in the paragraph immediately preceding the purported rationale for modifying Ludwig) that Silver "discloses location determination units for locating the mobiles with positioning request by external elements such as location..." The rejection cites the paragraph at col.9, lines 13-29, of Silver, which reads as follows:

"This is accomplished by providing a method and means by which a Location Service Node 200 providing location-based service and receiving a Service Request message can obtain information representing the current location of the MT 130. Upon receipt of a Service Request, the Location Service Node 200 transmits a Location Query to the HLR 114. A series of Location Queries are then transmitted in succession by the VLR 115, to the MSC 113B and ultimately to the SGSN 121. In response to the Location Query, SGSN 121 provides location information, such as that described with reference to FIGS. 1, 2 and 4, indicating the approximate location of the MT 130 within the voice network 100. Successive messages bearing such location information are transmitted in series back to the Location Service Node 200. Location-based services are then provided with reference to such information representing the current geographic location of the MT 130."

A "Location Service Node" 200 is thus discussed in Silver. But there is no disclosure that this element, a first station or other network element in Silver is provided with a dedicated address for receiving a request from an external element as to the location of this first station. There is also no disclosure that any request received at the dedicated address is a position request. Therefore, even if Ludwig was combined with Silver, it would not result in the claimed invention because neither document has any disclosure of providing one of the first station and at least one network element with a dedicated address which is arranged to receive a request from the external element as to the location of the first station, wherein any request received at that dedicated address is a position request.

Secondly, the rejection concludes that it would have been obvious to modify Ludwig to generate a request to a location center, and to provide the exact location of the mobile with prior identification of the requester in order to provide security and privacy to the mobile station (see page 3, last four lines, of the Office Action). The rationale for this conclusion of obviousness is not stated. In particular, it is not indicated if or how it is asserted that a supporting rationale would be garnered by one of ordinary skill in the art

from the Silver patent when considered as a whole. As noted above, the independent claims do not recite merely generating a request to a location center or providing the exact location of a mobile with prior identification of the requester. There is no citation to any portion of Silver that is asserted to provide a supporting rationale. Indeed, the rationale in the current obviousness rejection (see page 3, second paragraph, of the current Office Action) is the same as the rationale in the obviousness rejection in the two previous Office Actions even though Silver wasn't even applied in the previous obviousness rejections or cited in the previous Office Actions. Therefore, there is no prima facie case of obviousness because there is no rationale set forth to support for the proposed combination of references.

Silver is not prior art

Applicants also respectfully traverse the rejection on the alternative grounds that Silver is not prior art with respect to this application. This application claims the priority benefit of the June 9, 1999 filing date of United Kingdom Application No. 9913453.8. Each one of the pending claims is supported by this priority application and is thus entitled to the June 9, 1999 priority date.


The July 23, 1999 filing date of the application that issued as the Silver patent is after the June 9, 1999 priority date for the pending claims of this application. Silver does include a priority claim to Provisional Application No. 60/094,035 filed on July 24, 1998. However, this provisional application does not include the Location Service Node 2000 (or any other location determination units) in the paragraph of Silver cited in the rejection and quoted above. Therefore, the rejection should be withdrawn for the reason that Silver is not prior art with respect to this application.

No fees are believed to be necessary. However, the Commissioner is hereby authorized to charge any fees necessary for the consideration of this Response, or to avoid abandonment of this application, to Deposit Account No. 13-0760 (Docket No. 06173.4009US).

Respectfully submitted,

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Date


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